

### **REMARKS/ARGUMENTS**

Claims 1, 3, 4, 6-8, 10, 11, 14, 15, 21-33, 35 and 44-49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Riedy et al. (5,108,474), in view of Schultheiss et al. (2003/0000389 A1).

Riedy discloses a smoke filter of at least 3 layer construction. The filter construction consists of a prefilter layer comprising non-woven glass, a protective foam layer and a membrane layer. Riedy does not disclose the use of an electrostatic charge on the prefilter layer.

Schultheiss et al. ("Schultheiss") teaches the use of triboelectret fiber mixtures in a prefilter media. Schultheiss does not describe or suggest the combination of triboelectret prefilter media and membrane filtration media. Thus it would be not obvious to one of skill in the art to construct a composite filter media comprising a membrane filtration layer and at least one meltblown filtration media layer having an electrostatic charge disposed directly on the upstream side of the membrane filtration layer.

The invention herein uses a meltblown filtration media layer having fibers of less than 5  $\mu$ m. The fibers have an electrostatic charge. The meltblown media is disposed directly on the upstream side of a membrane filtration layer. Riedy specifically teaches away from such a construction by indicating that prefiltration media may cause damage which prevents effective function of the membrane filtration layer. Accordingly, the specific construction described and claimed has not been disclosed or suggested in Riedy, nor would the addition of electrostatic charge, as described in Schultheiss, lead one to the claimed invention. The specific materials described and claimed herein have demonstrated surprising dust holding capacity can be achieved thereby.

The Patent and Trademark Office has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. See In re Piasecki, 223 USPQ 785, 787 (Fed. Cir. 1984). It can satisfy this burden only by showing some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Lalu, 223 USPQ 1257, 1258 (Fed. Cir. 1984); see also Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 227 USPQ 657, 667 n. 24 (Fed. Cir. 1985); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984). In other words, elements of separate patents cannot be combined where there is no suggestion of such combinations.

Panduit Corp. v. Dennison Mfg. Co., 1 USPQ 2d 1593, 1597 (Fed. Cir. 1987),  
*cert. denied*, 107 S.Ct. 2187 (1987).

In considering the propriety of the Office's 35 U.S.C §103 obviousness type rejection in this matter, the proper determination to be made is whether a combination of the teachings of all or any of the references which have been cited by the Office would have suggested (expressly or by implication) the possibility of achieving further improvement by combining such teachings along the line of Appellants' invention. In re Sernaker, 217 USPQ 1 (Fed. Cir. 1983).

The Court of Appeals for the Federal Circuit has repeatedly held that to imbue one of ordinary skill in the art with knowledge of the invention, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W. L. Gore, 220 USPQ at 312-313.

The Federal Circuit also spoke to this problem in In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). The court stated that although "evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art or, in some cases, from the nature of the problem to be solved . . . [t]he range of sources available does not diminish the requirement for actual evidence. That is, the showing must be **clear and particular**." In re Dembiczak, 50 USPQ2d at 1617 (emphasis added). The court went on to say that "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" Id. The Supreme Court's recent ruling in KSR Int'l Co. v. Teleflex Inc., 550 U.S. --, 127 S.Ct. 1727, 1740 (2007) does not upset this tenet.

Based on the foregoing, Applicants believe that all pending claims are in condition for allowance and such disposition is respectfully requested. In the event that a telephone conversation would further prosecution or expedite allowance, the Examiner is invited to contact the undersigned.

Respectfully submitted,



Richard W. Ellis, 46,683  
W. L. Gore & Associates, Inc.  
551 Paper Mill Road  
P.O. Box 9206  
Newark, DE 19714-9206  
(302) 738-4880

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